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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,447	02/09/2001	Dipak K. Banerjee	P19850.p06	6690

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EXAMINER

OWENS JR, HOWARD V

ART UNIT PAPER NUMBER

1623

DATE MAILED: 11/05/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/779,447

Applicant(s)

BANERJEE ET AL.

Examiner

Howard V Owens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-92 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-92 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 4, 6, 8, 10-15 and 17, drawn to a method of inhibiting angiogenesis using a nucleoside, classified in class 514, subclass 42+.
  - II. Claims 5, 7, 9 and 18 drawn to a method of inhibiting angiogenesis using a nucleoside and at least one tunicamycin, classified in class 514, subclass 49+.
  - III. Claims 2, 3 and 16 drawn to a method of inhibiting angiogenesis using a nucleoside and glucosamine, classified in class 514, subclass 61.
  - IV. Claims 19-27, drawn to a method of inhibiting angiogenesis using an N-glycosylation inhibitor, classified in class 424, subclass 137.1+.
  - V. Claims 28-31, drawn to a method of inhibiting angiogenesis using an agent which induces ER stress in capillary endothelial cells, classified in class 514, subclass 8+.
  - VI. Claims 32-37, drawn to a method of inhibiting angiogenesis using an agent which induces unfolded protein response, classified in class 514, subclass 21+.
  - VII. Claims 38-42 and 73-77 drawn to a method of inhibiting angiogenesis using an agent which inhibits dolichol pathway, classified in class 514, subclass 23+.

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- VIII. Claims 43-47 and 78-82 drawn to a method of inhibiting angiogenesis using a biosynthesis inhibitor , classified in class 514, subclass 2+.
- IX. Claims 48-53, drawn to a method of inhibiting angiogenesis using a transferase inhibitor, classified in class 424, subclass 94.1+.
- X. Claims 54-58 , drawn to a method of inhibiting angiogenesis using an agent which reduces Dol-P-Man synthase activity, classified in class 514, subclass 7+.
- XI. Claims 59-66, drawn to a method of inhibiting angiogenesis using a non-peptide , classified in class 514, subclass 2+.
- XII. Claims 67-72, drawn to a method of inhibiting angiogenesis comprising inducing accumulation of Factor VIII:C, classified in class 424, subclass 198.1+.
- XIII. Claims 83-87, drawn to a method of inhibiting angiogenesis comprising administering a cell permeable apoptosis agent, classified in class 514, subclass 23+ .
- XIV. Claims 88-92, drawn to a method of inhibiting angiogenesis comprising administering a cell permeable agent to reduce intratumoral microvascular density, classified in class 514, subclass 2+.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I and X-XIV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially

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different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case Groups I – XIV are related as distinct methods of achieving the inhibition of angiogenesis with divergent agents.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. To search fourteen distinct and divergent inventions would impose an undue burden upon an examiner assigned this application.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group X-XIV, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Howard V. Owens  
Patent Examiner  
Art Unit 1623

A handwritten signature in black ink, appearing to read "James O. Wilson", written over a horizontal line.

James O. Wilson  
Supervisory Patent Examiner  
Technology Center 1600

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Owens whose telephone number is (703) 306-4538 . The examiner can normally be reached on Mon.-Fri. from 8:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the Supervisory Patent Examiner signing this action, James O. Wilson can be reached on (703) 308-4624 . The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.